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## REMARKS

### **Amendments to the Claims**

With the present submission, Applicants have amended claims 1, 2, 21-23, and 31-32. No claim has been canceled or added. As such, claims 1-32 are under consideration.

Specifically, Applicants have amended claims 1 and 2 to remove the terms "about" from the recited ranges in order to more precisely define the claimed invention. Applicants have also amended claims 21-23 to correct certain apparent and unintended errors in the numbering of the claims from which these claims depend. Moreover, Applicants have rewritten claims 31 and 32 to recite "[a] composition comprising the siNA molecule ... in a pharmaceutically acceptable carrier or diluent," which better describes the claimed composition. These amendments do not change the scope of the claims as previously presented and are fully supported by the specification as-filed. As such, no new matter has been introduced.

### **The Restriction Requirement**

The Office required restriction under 35 U.S.C. § 121 to one of the allegedly distinct inventions listed in Groups I-II. *See* Restriction Requirement, at page 2. Specifically, the Office deemed the multifunctional siNA molecule of Formula I "unrelated" to the molecule of Formula II. *See, id.*

Applicants respectfully traverse. As acknowledged by the Office, "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together **and** they have different designs, modes of operation, and effects." *Id.* (citing MPEP 803.01 and 806.06). Consistent with this acknowledged standard, the MPEP further explains that "[r]elated inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; ... and the inventions as claimed are **either** not capable of use together or can have a materially different design, mode of operation, function, or effect." MPEP 806.05(j) (*emphasis added*). It is respectfully noted that this standard is thus a 3-part requirement, and ***failing one of the requirements would render restriction improper***. It is further noted that the last part of this quoted section is stated in the alternative. Therefore, if the claimed embodiments fail either of the stated conditions, those embodiments are not sufficiently "distinct" so as to require restriction. In other words, if the claimed embodiments are capable of being used together **or** do not have materially different design, mode of operation, function or effect, these embodiments

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should be examined together on the merits.

Here, the claimed molecules of Groups I and II (according to Formula I and Formula II, respectively) fall within the same class and subclass. *See id.* Also, they can be used together, and are in fact intended to be used together under appropriate circumstances by the instant Applicants. The specification as filed states, for example, at page 66, paragraph [0173]:

The nucleic acid molecules of the instant invention, individually, or *in combination* or in conjunction with other drugs, can be used to treat diseases or conditions discussed herein (e.g., cancers and other proliferative conditions, viral infection, inflammatory disease, autoimmunity, pulmonary disease, renal disease, ocular disease, etc.). For example, to treat a particular disease or condition, the multifunctional siNA molecules can be administered to a subject or can be administered to other appropriate cells evident to those skilled in the art, individually or in combination with one or more drugs under conditions suitable for the treatment.

*(emphasis added).* Therefore, the molecules of Groups I and II are fully capable of being used together and all pending claims should be examined together.

Without acquiescing to the Office's contentions, and solely in the interest of advancing prosecution, Applicants hereby elect group I, including claims 1, 3-7, 13, 14, 17-23 and 31, but respectfully urge withdrawal of the restriction requirement and rejoinder of the claims in Group II at the earliest juncture.

### **Conclusion**

For the reasons described above, Applicants respectfully request early examination on the merits. If the Examiner believes a telephonic conference would advance prosecution, she is urged to call the undersigned at the number below.

Respectfully submitted,

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